

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 9, 2005. In the Office Action, Claims 1-41 are pending and the Examiner rejects Claims 1-41. Applicants note with appreciation the Examiner's acceptance of the drawings filed on December 13, 2001. Applicants amend Claims 1, 2, 6-9, 11, 12, 16-19, 22, 23, 27-30, 32, 33, and 37-40. Applicants submit that the claim amendments do not add new matter. Applicants respectfully request reconsideration and favorable action in this case.

Rejections Under § 102

The Examiner rejects Claims 1, 3-5, 7, 11, 13-15, 17, 22, 24-26, 28, 32, 34-36, and 38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,825,869 issued to Brooks et al. ("*Brooks*"). Applicants respectfully traverse the rejection of the claims and request reconsideration and favorable action.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P § 2131 (*emphasis added*). Whether considered alone or in combination with any other cited references, *Brooks* does not disclose, either expressly or inherently, each and every element of Applicants' claims.

Independent Claim 1, as amended, recites the following:

A method for routing calls of an automatic call distributor system, comprising:

receiving, from a user, a request for connection with one of a plurality of agents having one of a plurality of skills;

identifying at least first and second agents of the plurality of agents, the first and second agents each having at least the one of the plurality of skills;

the first and second agents being available for connection with the user along first and second communication paths, respectively;

receiving a measurement of at least one network parameter regarding each of the first and second communication paths;

identifying a generally unique skill of the plurality of skills; and

routing the request along a preferred communication path of the first and second communication paths based upon the availability of the first and second agents and the measurement of the at least one network parameter, the preferred communication path being selected to attain a higher probability that the generally unique skill will remain available for receiving a future request for connection.

Thus, Claim 1 recites a method for routing calls that includes, *inter alia*: (1) receiving a measurement of at least one network parameter regarding each of the first and second communication paths; (2) identifying a generally unique skill of the plurality of skills; and (3) routing the request along a preferred communication path of the first and second communication paths based upon the availability of the first and second agents and the measurement of the at least one network parameter.

Applicants respectfully submit that *Brooks* does not disclose, teach, or suggest the combination of features and operations enumerated above. *Brooks* discloses a call management system and method that routes “calls to the individuals based upon a correlation of attributes of the individuals with calls that are tagged with identification of abilities that are advantageous to efficiently processing the calls.” (Column 4, lines 51-57). Specifically, *Brooks* discloses that “two factors, skill score and preference score, can be combined in four different ways to produce four unique agent selection methods.” (Column 11, lines 28-30). The four different ways include a skills-only method, a preference-only method, a skills-first method, and a preferences-first method. (Column 11, line 28 through Column 12, line 15). “Skills” refers to the agents’ levels of skills, and “preferences” refers to the “call-management preferences for calls requiring specific skills or involving particular customers.” (Column 11, lines 30-32 and 49-51). The different methods are applied as disclosed when “more than one agent is available to handle a call when the call arrives at the call center.” (Column 11, lines 32-36). There is no disclosure in *Brooks*, however, of “receiving a measurement of at least one network parameter regarding each of the first and second communication paths,” as recited in Claim 1. As a result,

Brooks also cannot be said to disclose, teach, or suggest "routing the request along a preferred communication path of the first and second communication paths based upon the availability of the first and second agents and the measurement of the at least one network parameter," as also recited in Claim 1. The recited operations are absent from *Brooks*.

Independent Claims 7, 11, 17, 22, 28, 32, and 38 are also distinguishable from the system and method disclosed in *Brooks*. As just one example, Claim 7 recites that "the preferred agent is selected according to a statistical analysis using variables including a measurement of at least one network parameter regarding a communication path between the user and the preferred agent, and an impact of connecting the user with the preferred agent upon the availability of a generally unique skill of the plurality of skills, to a future user." Claims 17, 28, and 38 recite certain features that are analogous to the recited features of Claim 7. As still another example, Claim 11 recites a processor operable to "receive a measurement of at least one network parameter regarding each of the first and second communication paths" and "select a preferred communication path of the first and second communication paths based upon the availability of the first and second agents and the measurement of the at least one network parameter, for routing the request, the preferred communication path being selected to attain a higher probability that the generally unique skill will remain available to future users." Claims 22 and 32 recite certain features that are analogous to the recited features of Claim 11. Accordingly, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that *Brooks* does not disclose, teach, or suggest each and every limitation of Applicants' Claims 7, 11, 17, 22, 28, 32, and 38. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 7, 11, 17, 22, 28, 32, and 38.

Additionally, and with respect to Claim 11, the Examiner states that the claimed "port" is inherent. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." M.P.E.P. § 2112; *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the

allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In this case, the Examiner has not provided a basis in fact and/or technical reasoning to support the determination that the port necessarily flows from the teachings of *Brooks*. Accordingly, Applicants respectfully submit that the rejection of Claim 11 is improper.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 1, 7, 11, 17, 22, 28, 32, and 38, together with the Claims that depend from Claims 1, 7, 11, 17, 22, 28, 32, and 38.

Rejections Under § 103

The Examiner rejects Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Brooks* in view of U.S. Patent No. 6,879,586 issued to Miloslavsky et al. ("*Miloslavsky*").

Dependent Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41 each depend from an independent claim discussed above. Since Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41 incorporate the limitations of their respective independent claims, which Applicants have shown above to be allowable, Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41 are allowable for at least this reason.

Additionally, the claims recite features and operations that are distinguishable from the art. For example, Claim 21 recites that "voice quality is determined using one of a plurality of parameters including jitter, delay, and echo." Claim 41 also recites that "the statistical analysis further includes voice quality available along the communication path." With respect to Claims 21 and 41, however, the Examiner has not indicated where in either *Brooks* or *Miloslavsky* such elements are found. Instead, the Examiner merely states that "the use of a different bandwidth ensures the voice quality as previously discussed in claims 2, 8, 12, 23, 29, 33, and 39." (Office Action, page 5). In doing so, Applicants respectfully submit that the Examiner is not giving credence to each element of Applicants claims. The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496

(C.C.P.A. 1970)). Because the Examiner has not shown where the combination of elements recited in the claims is disclosed in either *Brooks* or *Miloslavsky*, Applicants submit that the rejection of Claim 21 and 41 are improper and should be withdrawn.

Furthermore, the M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Applicant’s disclosure. *See Id.* (citations omitted). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a

blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

In the Office Action, the Examiner acknowledges that *Brooks* does not explicitly teach the limitations recited in Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41. (Office Action, pages 4-6). In maintaining the rejections of the Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41, the Examiner speculates that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize certain bandwidth ports to receive customers’ requests in a call center, as taught by *Miloslavsky*, into the *Brooks* system in order to use a bandwidth that is sufficient for the need of the incoming call which improves the quality of communication between callers and agents.” (Office Action, page 5). The Examiner’s summary conclusion, however, amounts to mere speculation and does not provide the suggestion or motivation necessary to make the proposed combination.² The mere possibility that a modification might improve *Brooks*, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to modify the teachings of *Brooks*. Applicants respectfully submit that in making this unobvious leap the Examiner has used the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit. Accordingly, Applicants respectfully submit that the rejection of Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41 is improper.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2, 8, 10, 12, 18, 20-21, 23, 29, 31, 33, 39, and 41.

² If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for modifying *Brooks*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to modify *Brooks*, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

The Examiner rejects Claims 6, 9, 16, 19, 27, 30, 37, and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Brooks* in view of U.S. Patent No. 6,728,358 issued to Kwan ("*Kwan*").

Dependent Claims 6, 9, 16, 19, 27, 30, 37, and 40 each depend from an independent claim discussed above. Since Claims 6, 9, 16, 19, 27, 30, 37, and 40 incorporate the limitations of their respective independent claims, which Applicants have shown above to be allowable, Applicants have not provided detailed arguments with respect to Claims 6, 9, 16, 19, 27, 30, 37, and 40. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 6, 9, 16, 19, 27, 30, 37, and 40.

Additionally, Applicants reiterate the standard for establishing a *prima facie* case of obviousness discussed above. In the Office Action, the Examiner acknowledges that *Brooks* does not explicitly teach the features recited in Claims 6, 9, 16, 19, 27, 30, 37, and 40. (Office Action, pages 5-6). In maintaining the rejection of the claims, the Examiner speculates that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of parameters consisting of delay, jitter, and echo, as taught by *Kwan* into the *Brooks* system in order to enhance the quality of the system. The use of well-known techniques for improving the quality of the communication, as taught by *Kwan*, would have been obvious." (Office Action, page 6). The Examiner's summary conclusion, however, amounts to mere speculation and does not provide the suggestion or motivation necessary to make the proposed combination.³ The mere possibility that a modification might improve *Brooks*, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to modify the teachings of *Brooks*. Applicants respectfully submit that in making this unobvious leap the Examiner has used the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit. Accordingly, Applicants respectfully submit that the rejection of Claims 6, 9, 16, 19, 27, 30, 37, and 40 is improper.

³ If the Examiner is relying on "common knowledge" or "well known" art in support of his rationale for modifying *Brooks*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to modify *Brooks*, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

Furthermore, it is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). As discussed above, *Brooks* is directed to a call management method and system “for distributing calls to individuals, such as ACD agents.” (Abstract). By contrast, *Kwan* is directed to a system “for the efficient allocation of buffers (e.g., first-in first-out (FIFO) queues) for current and predicted active speakers in voice conferencing systems.” (Abstract). Thus, *Brooks* and *Kwan* propose very different solutions for the purposes of fulfilling very different objectives. Accordingly, Applicants respectfully submit that one of ordinary skill in the art at the time of invention would not have been motivated to combine the disclosure of *Brooks* with the disclosure of *Kwan*. Furthermore, there is no explicit or implicit reference in either reference which would suggest to one of ordinary skill to combine the call management system of *Brooks* with the conferencing system of *Kwan*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 6, 9, 16, 19, 27, 30, 37, and 40.

CONCLUSION

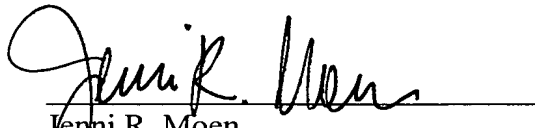
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorneys for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe that no fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS, L.L.P.
Attorneys for Applicants


Jenni R. Moen
Reg. No. 52,038

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Correspondence Address:

at Customer No. **05073**